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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/326,020	06/04/1999	JOHN ROBERT PORTER	CELL-0072	3600

7590 03/26/2004

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EXAMINER

ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 03/26/2004

43

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/326,020

Applicant(s)

PORTER ET AL.

Examiner

Binta M. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **Detailed Action**

Claims 1, 5-13 are pending in the application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 5-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claim 1, line 8, page 3, the phrase "salts, solvates, hydrates or N-oxides thereof" is indefinite and ambiguous. A compound can only contain one compound, not several compounds. Claims 1 and 5-12 are contradictory because they are simultaneously claiming a singular "compound" and yet "more than one compound" by claiming the "and salts, solvates, hydrates or N-oxides thereof." Is the applicant claiming "a compound" or a "mixture" which contains at least two more compounds? Also, it is not clear as to what hydrates, solvates or N-oxides of the compound the applicant is claiming.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim(s) 1,5,7,8, 10, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ca 124:56589 et. al. (See Reference U). Ca 124:56589 discloses the instant compounds, L-Tyrosine, N-acetyl-O-(2-pyridinylmethyl) and L-Tyrosine, N-acetyl-O-(4-pyridinylmethyl)-, and L-Tyrosine, N-acetyl-O-(3-pyridinylmethyl)-. At page 1, see the instant compounds.

Claim(s) 1,5,7,8,10, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ali (See Reference N). Ali et. al. discloses the instant compound, L-Tyrosine, -[3-(6-amino-2-pyridinyl)propyl]propyl]-N-(butylsulfonyl)-. At pages 1-118, see the instant compound.

Claim(s) 1,5,7,8,10, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ca 86:107036 (See Reference V). Ca 86:107036 et. al. discloses the instant compound, L-Tyrosine, N-[(1,1-dimethylethoxy)carbonyl]-O-(4-pyridinylmethyl)-. At page 1, see the instant compound.

Claim(s) 1,5, 6, 7,8,10, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Chung et. al. (See Reference W, Tetrahedron, Vol 49, No. 26, page 5770). Chung et. al. discloses the instant compound, L-Tyrosine, N-(Butylsulfonyl)-O-[4-(4-pyridinyl)butyl] . At page 5770, see the instant compound, compound 14.

Claim(s) 1,5, 6, 7,8, 9, 10, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lobl et. al. (See Reference A). Lobl et. al. discloses the instant compounds, 77, 208, 209, 210, at column 147, column 194, lines 5-15, column 194, lines 40-50, column 195, lines 15-20, respectively and compound, L-Phenylalanine, N-[[[(1s, 3R)-3-carboxy-2,2,3-trimethylcyclopentyl]carbonyl]-4-[(2-pyridinylcarbonyl)amino]-,

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alpha methyl ester, compound, L-Tyrosine, N-[(1, 1-dimethylethoxy)carbonyl]-O-[5-[(4,6-diphenyl-2-pyridinyl)oxy]pentyl] at columns 1-242.

Claim(s) 1,5, 6, 7,8, 9, 10, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Thorsett et. al. (See Reference P). Thorsett et. al. discloses the instant compound, L-phenylalanine, N-[[1-methyl[(phenylmethyl)sulfonyl]amino]cyclopentyl]carbonyl]-4-[[4-pyridinylcarbonyl]amino. At pages 1-141, see the instant compound.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,5, 6, 7,8,10, 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al. (See Reference A, US Patent 5206373). Chung et. al. teaches the instant compound genus as shown in claim 1, at column 12, lines 5-14, wherein R1 is 4-pyridinyl, m is an integer from two to six, and R4 is C1-10 alkyl. At column 12, see lines 5-14, see the radicals defined. The difference between the prior art compound and the instantly claimed compounds is the teaching of a generic compound versus a disclosed species. It would have been obvious to one of ordinary skill in the art to select various known radicals within a genus to prepare structurally similar compounds. For instance, see the compound, L-Tyrosine, N-(Butylsulfonyl)-O-

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[4-(4-pyridinyl)butyl], at column 4, line 50, where a disclosed species is exemplified.

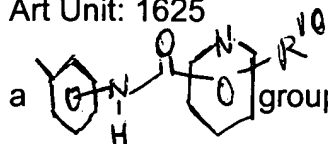
Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

Claims 1, 5, 6, 7, 8, 10, 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al. (See Reference O, WO 93/16994). Chung et. al. teaches the instant compound genus as shown in page 2, lines 25-33, wherein R1 is a six member unsaturated heterocyclic ring containing one N heteroatom, m is an integer from two to six and R4 is C1-10 alkyl. At page 2, lines 25-33, see the instant compound genus and the radicals defined. The difference between the prior art compound and the instantly claimed compounds is the teaching of a generic compound versus a disclosed species. It would have been obvious to one of ordinary skill in the art to select various known radicals within a genus to prepare structurally similar compounds. For instance, see the compound, 1-8, at page 8, lines 5-10, where a disclosed species is exemplified. Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over . Lobl, (see Reference A)

Lobl et. al. teaches the instant compound as shown in Formula I, where n is an integer of 0 or 1, R1 is a hydrogen or methyl group, R3 is a hydrogen or a methyl group, X is a -CO- group, R4 is a hydrogen atom or a C1-6 alkyl group, R5 is a -COOH group, R6 is

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group, and R<sup>10</sup> which occurs one or more times and which may be the same or different in each occurrence, is H, F, Cl, Br, or I, -NO<sub>2</sub>, C1-6 alkyl or C1-6 alkyl. At columns 235-237, see formula I and the radicals defined. The difference between the prior art compound and the instantly claimed compounds is the teaching of a generic compound versus a disclosed species. It would have been obvious to one of ordinary skill in the art to select various known radicals within a genus to prepare structurally similar compounds. For instance, see compound, 77, at column 147, where a disclosed species is exemplified. Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is 571-272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.

BMR  
3/18/04

  
CEILA CHANG  
PRIMARY EXAMINER  
GROUP 1200-1625

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Binta Robinson

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